

ESTTA Tracking number: **ESTTA694391**

Filing date: **09/08/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213744
Party	Defendant Pearl Enterprises, LLC
Correspondence Address	CHRISTOHER R KINKADE FOX ROTHSCHILD LLP 997 LENOX DRIVE, BUILDING 3 LAWRENCEVILLE, NJ 08648 UNITED STATES lkarczewski@foxrothschild.com
Submission	Opposition/Response to Motion
Filer's Name	Christopher R. Kinkade
Filer's e-mail	ipdocket@foxrothschild.com, ckinkade@foxrothschild.com, lkarczewski@foxrothschild.com
Signature	/Christopher R. Kinkade/
Date	09/08/2015
Attachments	91213744 Applicant's Opposition to Opposer's Motion for Leave to Amend Notice of Opposition 2015-09-08.pdf(33699 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

YUKO FUJITA,

Opposer,

v.

PEARL ENTERPRISES, LLC,

Applicant.

Opposition No. 91213744

Mark: KINOKI

Serial No. 85941092

Published in *Official Gazette*:  
September 10, 2013

**APPLICANT’S OPPOSITION TO OPPOSER’S  
MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

Applicant Pearl Enterprises, LLC (“Applicant”) respectfully submits this memorandum in opposition to Opposer Yuko Fujita’s (“Opposer”) Motion for Leave to Amend Notice of Opposition dated August 19, 2015 (the “Motion”). In support of its opposition, Applicant states the following.

1. Opposer’s Motion is untimely and futile.
2. Opposer seeks to amend the Notice of Opposition to add a new ground for opposition—namely, that the application is allegedly void *ab initio*—five weeks after the close of discovery on July 15, 2015 and only ten days before Opposer’s pretrial disclosures were due.
3. Opposer alleges that “she was unaware of specific facts supporting the opposition to the registration of Applicant’s KINOKI mark on the grounds that Applicant’s application was void *ab initio*.” However, all of the facts that Opposer relies upon for the Motion are part of the prosecution history of Applicant’s application that is the subject of this opposition and thus were available to and reasonably should have been known by Opposer prior to the filing of this opposition proceeding.

4. Although Opposer does not explain the basis for the Motion in the Motion itself, the basis that can be gleaned from the proposed First Amended Notice of Opposition is that Applicant's specimen allegedly "does not show use of Applicant's KINOKI mark in connection with any of the products recited in Applicant's application." (Proposed First Amended Notice of Opposition at ¶ 16.)

5. As Opposer points out in the Proposed First Amended Notice of Opposition, Applicant filed a Preliminary Amendment to its identification of goods on May 31, 2013, which was processed on June 1, 2013, but which the trademark examining attorney inadvertently did not enter before publication. (*See* Proposed First Amended Notice of Opposition at ¶¶ 5-6.)

6. All of these facts, as well as all of the alleged facts under Count II in Opposer's Proposed First Amended Notice of Opposition (paragraphs 13-18), are based on the file history of Applicant's application and thus have been available to Opposer since the filing of this opposition proceeding.

7. Even if the Board deems Opposer's Motion to be timely, the Motion is futile, because Applicant's specimen depicts goods within the scope of the identification of goods in Applicant's application.

8. Applicant's Preliminary Amendment revised the identification of goods to recite, "Aromatic body care products, namely, non-medicated body and foot scrubs in the form of cleansing foot pads for cosmetic purposes."

9. The original identification of goods was, "Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream."

10. Applicant's specimen is within the scope of both Applicant's original and amended identification of goods.

11. Opposer now requests that the Board invalidate Applicant's application based on an apparently inadvertent error by the trademark examining attorney, when Applicant has fulfilled its obligations to the Office.

12. In the alternative, if the Board deems the Motion timely and not futile, Applicant respectfully requests that the discovery period be reopened so that Applicant may seek discovery into Opposer's newly proposed ground for opposition. Opposer's newly alleged ground for opposition bears at least on the issue of the scope of the goods and services recited in the parties' respective applications and whether Applicant's goods are likely to cause confusion with those recited in Opposer's registration.

WHEREFORE, Applicant respectfully requests that the Board deny Opposer's Motion. In the alternative, if the Board grants Opposer's Motion, Applicant respectfully requests that discovery be reopened so that Applicant may seek discovery into this new ground for opposition.

Respectfully submitted,

Dated: September 8, 2015

FOX ROTHSCHILD LLP

*Attorneys for Applicant Pearl Enterprises, LLC*

/Christopher R. Kinkade/  
Christopher R. Kinkade  
Lisa A. Karczewski  
997 Lenox Drive, Bldg. 3  
Lawrenceville, NJ 08648-2311  
T: (609) 844-3023; F: (609) 896-1469  
Email: ipdocket@foxrothschild.com  
ckinkade@foxrothschild.com  
lkarczewski@foxrothschild.com

**CERTIFICATE OF SERVICE**

I hereby certify that on this 8th day of September, 2015, a true and correct copy of the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION** has been served via email and first-class mail upon the following counsel of record for Opposer:

Annette P. Heller  
Heller & Associates  
400 Chesterfield Center, Suite 400  
Chesterfield, MO 63017  
Tel: (314) 469-2610  
Fax: (314) 469-4850  
Email: tmattorneyheller@aol.com

*Attorney for Opposer Yuko Fujita*

/Christopher R. Kinkade/  
\_\_\_\_\_  
Christopher R. Kinkade  
FOX ROTHSCHILD LLP  
997 Lenox Drive, Building 3  
Lawrenceville, NJ 08648  
Tel: (609) 896-3600  
Fax: (609) 896-1469  
Email: ckinkade@foxrothschild.com

*Attorneys for Applicant Pearl Enterprises, LLC*